

Appl. No. 10/706,065
Response Dated March 16, 2007
Reply to O.A. of December 18, 2006

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REMARKS/ARGUMENTS

Claims 1-54 are pending and at issue in the present application.

Applicants traverse the rejection of claims 1-54 as failing to comply with the written description requirement. Further, applicants traverse the rejection of claims 53 and 54 as indefinite.

In response to the examiner's contention that there is no support for the claim recitation "without limitation as to position and orientation of the customized content over an entire surface of the at least one page," applicants respectfully call the examiner's attention to U.S. Patent No. 6,327,599 incorporated by reference in the present application. Specifically, applicants refer to column 7, lines 36-49 of the '599 patent wherein applicants state that:

It should be noted that the present invention is not limited to production of books of the same "version" (i.e., books having the same master information). For example, the book versions of FIGS. 7a, 7b and 8a, 8b may be produced together with the book version of FIG. 6a and 6b in the same production run or job. The book version example of FIGS. 7a and 7b includes pages P5-P8 to be reproduced a number of times to produce individual books. The book version of FIGS. 7a and 7b is identical to of the book version of FIGS. 6a and 6b except that an additional area 113 is provided on the page P5 for placement of variable information, in addition to the areas 110 and 112. Because of the addition of the area 113, the remaining master information appearing in an area 114 differs from master information appearing in an area 116 of the page P1 of FIG. 6a.

Referring to Figs. 6-8 of the '599 patent, it is evident that the demand printer disclosed therein is capable of printing customized content on at least a portion of at least one of the pages without limitation as to position and orientation of the customized content over an entire surface of at least one page.

Pursuant to 37 C.F.R. § 1.57(c), applicants expressly incorporated the '599 patent by reference, as pointed out in page 2, lines 1-2 and page 9, lines 8-11 of the specification as originally filed in the present application. Therefore, the foregoing provides ample support for the claimed subject matter.

With respect to claims 53 and 54, applicants respectfully call the examiner's attention to applicant's "Amendment C" dated October 13, 2006, wherein applicants amended claims 53 and

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54 to reflect their dependence on claim 52, which depends on claim 49, which in turn depends on independent claim 36, which recites a method of producing books.

Applicants traverse the rejection of the claims at issue as obvious over varying combinations of Dooley, Graushar or Weller and the '599 patent.

Claim 1, and claims 2-22 dependent thereon, recite book production apparatus including a gathering line operable during a single, continuous production sequence and a demand printer operable during the single production sequence for producing first and second different printed pages in response to print commands issued during the production sequence. The demand printer prints customized content on at least a portion of at least one of the pages without limitation as to position and orientation of the customized content over an entire surface of the at least one page. A feeding device is operable to feed the printed pages to the gathering line and a controller coordinates simultaneous issuance of the print command to the demand printer and operation of the gathering line, the demand printer, and the feeding device during the single production sequence to produce books.

Claim 23, and claims 24-35 and 43-48 dependent thereon, specify print production apparatus including a gathering line operable during a production sequence and a demand printer for producing first and second pages each having customized content that is disposed in an orientation at a position on a surface thereof. The first and second pages are printed during a time interval during which the gathering line is continuously moving. The demand printer includes means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page. A feeding device is operable to feed the customized pages to the gathering line and a controller coordinates operation of the gathering line, the demand printer, and the feeding device during the production sequence to produce customized books.

Claims 36-42 and 49-54 recite a method of producing books including the step of supplying a gathering line, a demand printer for producing first and second pages at least one of which has customized content printed on at least a portion thereof without limitation as to position and orientation of the customized content over an entire surface of the at least one page in response to

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print commands generated during a continuous production sequence, and further including the step of supplying a feeding device. The method also includes the step of coordinating simultaneous operation of the gathering line, the demand printer, and the feeding device during a production sequence to produce the books.

None of the art cited by the examiner discloses or suggests a book production apparatus including a demand printer operable during the single production sequence to produce different printed pages in response to print commands issued during a single continuous production sequence, wherein the demand printer prints customized content on at least a portion of at least one of the pages without limitation as to position and orientation of the customized content over an entire surface of the at least one page together with a controller that coordinates simultaneous issuance of the print commands to the demand printer and operation of a gathering line, the demand printer, and a feeding device during the single production sequence, as recited by claims 1-22.

Further, none of the prior art cited by the examiner discloses or suggests a book production apparatus including a demand printer for producing first and second different pages each having customized content that is disposed in an orientation at a position on a surface thereof, wherein the first and second pages are printed during a time interval during which a gathering line is continuously moving and wherein the demand printer includes means for printing the customized content on at least a portion of each page without limitation as to the orientation and position of the customized content over an entire surface of the page together with a controller that coordinates operation of the gathering line, the demand printer, and a feeding device during a production sequence to produce customized books, as recited by claims 23-35 and 43-48.

Still further, none of the art cited by the examiner discloses or suggests a method of producing books including the step of supplying a demand printer for producing first and second pages wherein at least one of the pages has customized content printed on at least a portion thereof without limitation as to position and orientation of the customized content over an entire surface of the at least one page together with the step of coordinating simultaneous operation of a gathering line, the demand printer, and a feeding device during a production sequence to produce books. These steps are recited by claims 36-42 and 49-54.

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In fact, each of Dooley, Graushar, and Weller discloses the use of customization printers that are fixed in position during a print job. While these customization printers may be movable (i.e., repositionable) between print jobs, it is clearly the case that each of these customization printers is capable of printing in only a selected position and orientation during a particular print job, and none of these customization printers is capable of printing without limitation as to position and orientation of customized content over an entire surface of a printed page in response to print commands issued or generated during a production sequence. The '599 patent discloses controlling an electronic press to print fixed and variable information. However, the '599 patent does not teach coordinating the simultaneous operation of a gathering line, a demand printer that is capable of printing without limitation as to position and orientation of customized content over an entire surface of a page, and a feeding device during a production sequence.

In an obviousness inquiry, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 682 (Fed. Cir.1990). The motivation to combine prior art to solve a problem may be found in any number of sources, including common knowledge, the prior art as a whole, or the nature of the problem itself. *Dyster Textilfarben GMBH v. C.H. Patrick Co.*, 464 F.3d 1356, 1361 (Fed. Cir. 2006). However, none of the cited references suggests that it would be feasible to achieve the degree of variability contemplated by the claimed subject matter, and there is simply no motivation to combine the features of the references to implement a book production apparatus or method as recited by claims 1-54. Furthermore, at least a reasonable expectation of success in combining prior art references is required to render an invention obvious. *In re Merck & Co.*, 800 F.2d 1091, 1096 (Fed. Cir.1986). There is no suggestion that a combination of any of Graushar, Dooley, or Weller with the '599 patent would have successfully resulted in a gathering line, a demand printer that is capable of printing without limitation as to position and orientation of customized content over an entire surface of a page, and a feeding device all operable during a single production sequence. Therefore, it follows that the claimed subject matter is not rendered obvious by the cited art.


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For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims and allowance thereof are respectfully requested.

Respectfully submitted,

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